REMARKS

This Amendment is responsive to the Office Action dated September 7, 2004. Applicant has amended claims 49, 52, 53, 55, 58, 62 and 65 for purposes unrelated to patentability. In addition, Applicant has added new claims 66-72. Claims 49-72 are pending upon entry of this Amendment.

Applicant would like to thank the Examiner for discussing the Office Action via telephonic interview on March 3, 2005. Ms. Mooneyham, Mr. Kent J. Sieffert, and Mr. Steve Abernethy participated in the interview. During the telephonic interview, the Applicant and the Examiner discussed the rejections of claims 49-54 and 57-63 under 35 U.S.C. 102(e) as being anticipated by Israel et al. (US 6,766,307).

During the interview, the Examiner and the Applicant agreed that Israel and the other prior art of record require a party to manually enter all information directly to the dispute resolution system from his or her client device. In addition, the Examiner and the Applicant agreed that the limitations of claim 54, which requires automatic communication of data between a database of the online dispute resolution system and a database of the electronic marketplace, appears to overcome the prior art of record. The Applicant also clarified that the term "electronic marketplace" as defined and used by the Applicant refers to a computer-implemented system and not to individuals.

In this response, Applicant has elected not to amend independent claims 49 and 58 to include the limitations of claim 54. As described in further detail below, the Examiner has erroneously relied on subject matter that does not qualify as prior art under 102(e).

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 49-54 and 57-63 under 35 U.S.C. 102(e) as being anticipated by Israel et al. (US 6,766,307). Applicant respectfully traverses the rejection. The Examiner has erroneously relied on subject matter that does not qualify as prior art under 102(e). 35 U.S.C. 102(e) states:

> A person shall be entitled to a patent unless: ...
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ...

The present application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000. Israel was filed May 11, 2000, which is nearly three months after Applicant's priority date of February 15, 2000, but claims priority to six U.S. provisional applications filed prior to the priority date of the present application.

MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

Applicant has reviewed the six U.S. provisional applications to which Israel claims priority (herein, "the Israel priority applications"). The Israel priority applications fail to even mention the subject matter on which the Examiner bases her arguments. In fact, the Israel priority applications fail to properly support much of the subject matter described in Israel. As a result, the subject matter relied upon by the Examiner as the basis for the 102(e) rejection was first filed in a U.S. patent application after the priority date of the present application. Thus, in accordance with MPEP 2136.03, the Examiner erroneously based the rejection under 102(e) on subject matter that does not qualify as prior art. Consequently, as further discussed below with respect to each claim, the 102(e) rejection must be withdrawn.

Claims 49, 58

Applicant's claim 49 is directed to a system as follows:

A system comprising:

an online dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services,

wherein the online dispute resolution system electronically receives transaction data from the electronic marketplace that describes transactions within the electronic marketplace, and

wherein the dispute resolution system utilizes the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Similarly, Applicant's claim 58 is directed to a method as follows:

A method comprising:

providing an online dispute resolution system electronically coupled to a marketplace that provides a website by which users buy and sell items;

electronically receiving with the online dispute resolution system transaction data from the marketplace that describes transactions within the marketplace; and

utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

In rejecting claims 49 and 58, the Examiner relied on FIG. 1, col. 6, ll. 10-24, col. 7, lines 43-52, and col. 16, ll. 26-46 to illustrate that the Israel system is electronically accessible via the Internet and that the parties electronically enter data into the Israel system. The Examiner then relied on col. 8, ln. 58 through col. 9, ln. 15 as the basis for concluding that Israel describes an online dispute resolution system that electronically receives transaction data from an electronic marketplace. In particular, the Examiner referred to this section of Israel and stated:

> This excerpt discloses a "hot link" embedded within a website which interacts with the system .... Israel states that this is especially useful when the web site of another entity is engaged in a business where disputes may occur, such as, for example, a **web site which sells goods or services** (on online marketplaces).[1]

However, the Israel priority applications fail to provide support for any such coupling between an online dispute resolution system and an electronic marketplace. In fact, the Israel priority applications do not provide any description of an electronic system that resolves disputes arising from the sale of goods or services.

To the contrary, the Israel priority applications describe an electronic system dedicated to the resolution of insurance disputes related to bodily injuries. The Israel priority applications only describe data relating to physical injuries and insurance claims. FIGS 1 and 2 of Israel are

[1] Final Office Action, pg. 9 (emphasis original).

not even shown in the Israel priority applications. The Israel priority applications make no mention of resolving disputes related to the online or offline sale of a good or service, and entirely fail to even mention buyers and sellers or a web site that sells goods or services. The Israel priority applications fail to even mention a system for resolving disputes arising from any form of e-commerce let alone an electronic marketplace. Thus, the Examiner's conclusion that Israel describes an electronic marketplace is based entirely on subject matter that is not properly supported by the Israel priority applications in compliance with 35 U.S.C. 112, 1st paragraph and, therefore, does not qualify as prior art under 102(e).

Moreover, the Israel priority applications fail to describe any mechanism whatsoever by which an external website interacts with the Israel dispute resolution system. The Israel priority applications make no mention of the use of "hot links" or URLs or any other mechanism that may be embedded within other websites. In fact, none of the subject matter described in col. 8, ln. 58 through col. 9, ln. 15 of Israel is even mentioned in the Israel priority documents let alone properly supported in compliance with 35 U.S.C. 112, 1st paragraph. For at least these reasons, the Examiner's conclusion that Israel teaches electronically receiving with the online dispute resolution system transaction data from the marketplace is also based on subject matter that is unsupported by the Israel priority applications and, therefore, does not qualify as prior art.

Consequently, the rejection of claims 49 and 58 under 35 U.S.C. 102(e) is clearly erroneous and must be withdrawn.

Claim 51 and 60

In rejecting claims 51 and 60, the Examiner refers exclusively to col. 8, ln. 58 through col. 9, ln. 15 in reference to Applicant's claim requirement of an online dispute resolution system that electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system. As described above, the subject matter relied upon by the Examiner is not described within the Israel priority documents. Thus, the Examiner's rejection of claims 51 and 60 is not based on subject matter that qualifies as prior art under 102(e). Consequently, the rejection of claims 51 and 60 must be withdrawn.

Claim 52

In rejecting claim 52, the Examiner refers to Israel et al. at FIGS 1-2, col. 9, ll. 16-42 and col. 10., ll. 32-65. In col. 9, Israel et al. describes a process for registering users with the online dispute resolution system. In col. 10, Israel et al. describes a "management module" of the dispute resolution system that "identifies, sorts, compiles, organizes, and stores" data, and that is configured to communicate with the dispute parties (or a mediator or arbiter) via electronic mail, facsimile or regular mail. The remaining paragraphs of col. 10 cited by the Examiner describe how the Israel system maintains a status of a dispute (e.g., OPEN or INACTIVE).

FIGS 1-2 of Israel are not shown within the Israel priority applications. Further, the subject matter described in col. 9, ll. 16-42 and col. 10., ll. 32-65 is not properly supported by the Israel priority documents in compliance with 35 U.S.C. 112, 1st paragraph. To the contrary, the provisionals merely describe a program manger (i.e., a human user) being able to sort cases and send an email. Thus, the Examiner's rejection of claim 52 is not based on subject matter that qualifies as prior art under 102(c). Consequently, the rejection of claim 52 must be withdrawn.

Claim 53

In rejecting claim 53, the Examiner relies on Israel et al. at FIGS 1-2, col. 9, lines 31-36 and col. 10, lines 32-65. FIGS 1-2 of Israel are not shown within the Israel priority applications. The subject matter described in col. 9, ll. 16-42 and col. 10., ll. 32-65 is not properly supported by the Israel priority documents in compliance with 35 U.S.C. 112, 1st paragraph. To the contrary, the provisionals merely describe a program manger (i.e., a human user) being able to sort cases and send an email. Thus, the Examiner's rejection of claim 53 is not based on subject matter that qualifies as prior art under 102(e). Consequently, the rejection of claim 53 must be withdrawn.

Claim 54

Applicant's claim 54 requires a data manager software application that automatically communicates data between a database of the online dispute resolution system and a database of the electronic marketplace. In rejecting claim 54, the Examiner again erroneously relies on col. 8, line 48 thru col. 9, ln. 67 and FIGS 1 and 2 of Israel, which do not qualify as prior art as shown above. In addition, the Examiner relies on col. 28, ln. 39 through col. 29., ln 15, which appears to be unsupported by the Israel priority documents. Thus, the Examiner's rejection of claim 54 is not based on subject matter that qualifies as prior art under 102(e). Consequently, the rejection of claim 54 must be withdrawn.

Moreover, the Applicant and the Examiner agreed during the telephonic interview that Israel requires a party to manually enter all dispute information into the dispute resolution system from his or her client device and that the elements of claim 54 appear to overcome Israel.

Claims 57 and 63

In rejecting claims 57 and 63, the Examiner erroneously relies on Israel et al. col. 8, line 48 thru col. 9, ln. 67, which does not qualify as prior art. The Examiner cites no other support for her rejection of claims 57 and 63. Thus, the Examiner's rejection of claims 57 and 63 are not based on subject matter that qualifies as prior art under 102(e). Consequently, the rejection of claims 57 and 63 must be withdrawn.

Claim 61

In rejecting claim 61, the Examiner erroneously relies on Israel et al. col. 8, line 49 thru col. 9, ln. 5 with respect to Applicant's claim requirement of electronically communicating data that relates to the online dispute resolution process to the electronic marketplace. As described above, the Israel priority applications do not support the cited subject matter. Thus, the Examiner's rejection of claim 61 is based entirely on subject matter that does not qualify as prior art under 102(e). Consequently, the rejection of claim 61 must be withdrawn.

Claim 62

In rejecting claim 62, the Examiner referred explicitly to the "hot links" described in col. 8, ln. 48 through col. 9, ln. 15 as visual indicia that are associated with users of an electronic marketplace that participate in the dispute resolution system. As described above, the Israel priority applications do not support the cited subject matter. The Examiner also cites col. 23, ln. 21-35, which describes a method for organizing users by organizing the disputes within color-coded categories. The Israel priority documents do not describe such as technique. Thus, the Examiner's rejection of claim 62 is not based entirely on subject matter that does not qualify as prior art under 102(e). Consequently, the rejection of claim 62 must be withdrawn.

Claims 64 and 65

In rejecting claims 64 and 65, the Examiner states that Israel discloses a system comprising an online dispute resolution system capable of receiving a query from a marketplace and again erroneously relies on Israel et al. col. 8, line 48 thru col. 9, ln. 67. The Examiner cites no other support for her rejection of claims 64 and 65. Thus, the Examiner's rejection of claims 64 and 65 are entirely based on subject matter that does not qualify as prior art under 102(e). Consequently, the rejection of claims 64 and 65 must be withdrawn.

For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 49-54 and 57-63 under 35 U.S.C. 102(e). Further, the Applicant maintains the arguments presented in previous communications with respect to the inapplicability of Israel to claims 49-54 and 57-63. Withdrawal of this rejection is requested.

Claim Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307) as applied to claim 49 above, and further in view of Sloo (US 5,895,450). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

In general, the Examiner proposes to modify the Israel system in view of Sloo. However, as described above, much of the subject matter described by Israel and relied upon by the Examiner does not qualify as prior art under 102(e) or 103. For at least this reason the rejection of claims 55 and 56 must be withdrawn.

New Claims:

Applicant has added claims 66-72 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions.

For example, each of independent claims 66 and 67 require the automatic communication of transaction data between a database of the electronic marketplace and a database of the online dispute resolution system. As defined by the American Heritage dictionary, the term "automatic" means "operating with minimal human intervention; independent of external control."[2] This ordinary meaning is consistent with Applicant's usage. Consequently, Applicant's claims 66 and 67 require the automatic communication of transaction data between a database of the electronic marketplace and a database of the online dispute resolution system without human intervention, where the transaction data is utilized in accordance with a dispute resolution process to assist parties to resolve the dispute.

The prior art of record fails to teach or suggest, storing transaction data an electronic marketplace, receiving case information with an online dispute resolution system, automatically communicating the transaction data from the electronic marketplace to the online dispute resolution system, and executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the dispute information from the parties to assist the users in resolving the dispute, as required by new claim 68.

Similarly, the prior art of record fails to teach or suggest storing transaction data an electronic marketplace, receiving case information with an online dispute resolution system, and executing a dispute resolution process with the online dispute resolution system that utilizes the

[2] www.dictionary.com

transaction data from the electronic marketplace and the dispute information to assist the parties in resolving the dispute, as required by new claim 69.

Similarly, the prior art of record fails to teach or suggest an electronic marketplace having a database that stores transaction data, an online dispute resolution system that presents an interface for receiving case information from one or more parties, wherein the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information to assist the parties in resolving the dispute, as required by new claim 70.

Similarly, the prior art of record fails to teach or suggest an online dispute resolution system having a database of case information a dispute, an electronic marketplace system that includes a database that stores transaction data that describe transactions for buyers and sellers, a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without manual intervention, and a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system, as required by new claim 71.

Claim 72 requires a server that provides an electronic marketplace system, a plurality of client computers by which buyers and sellers interact with the electronic marketplace system; and an online dispute resolution system that communicates with a database of the electronic marketplace system.

No new matter has been added by the new claims. Support for the new claims can be found throughout the present specification including, for example, [0046]-[0048].

CONCLUSION

Because of the Examiner's error, the final rejection must be withdrawn and the requested claim amendments must be entered. All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims.

Application Number 10/672,136
Responsive to Office Action mailed 2/17/2005

Please charge any additional fees or credit any overpayment to deposit account number 50-1778.

The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date: March 18, 2005

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